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| EXAMINER | |
|---|---|
| PORTKA, GARY J | |

| ART UNIT | PAPER NUMBER |
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| 2188 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/927,210 | ROBINSON, KURT B. | |
| | Examiner | Art Unit | |
| | Gary J. Portka | 2188 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date. _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. It is acknowledged that this is a reissue application of previous US Application 08/773,168, filed December 26, 1996, and issued as US Patent 5,937,423 on August 10, 1999. Claims 14-42 have been added, resulting in claims 1-42 now pending.

### *Response to Arguments*

2. Applicant's arguments filed in the parent case on January 19, 1999 have been fully considered but they are not persuasive with respect to the added claims. Applicants argued that in the Sukegawa reference the ROM with its firmware is not equivalent to the recited query memory storing data defining characteristics of the flash, and register interface adapting commands to the flash based on the data. Examiner responds that the claims rejected below do not fully include these limitations, and that in any case the ROM with firmware is not considered to be the recited query memory.

### *Claim Objections*

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 33 (first occurrence) has been renumbered 32.

### *35 U.S.C. 251 Reissue of defective patents.*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

6. Claims 22-27 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc.* v. *Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp.* v. *United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In the parent case, the limitation that the register interface generate signals for adapting the purpose of the commands in the device *based on the data* was added to

independent claims 1 and 11, and argued in the paper of January 11, 1999 as a part of the limitations that patentably defined the claims. It was also argued that the similar limitation of claim 8, *initializing a device driver for the device using the characteristics in the characteristic registers* contributed to the patentability of that claim and its dependent claims. It was thus clear at the time of allowance that Applicant considered the particular limitation of the characteristic data of the device to be used either for adapting commands, or for initializing a device driver, to be the patentable novelty. Claim 22 removes any such limitation, reciting only that there are attributes (equivalent to characteristic data) stored and provided, but not that it is used to adapt commands or initialize a device driver. These limitations are also not added in any of the claims dependent upon claim 22. Therefore, claims 22-27 attempt to recapture subject matter surrendered in the parent application, and are accordingly rejected.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 14-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Sukegawa et al., US 5,603,001.

9. As to claim 14, Sukegawa discloses *an apparatus* (Fig. 2) *comprising a processor* (1), *and a memory storage device comprising a memory array* (11-1 to 11-16) *comprising non-volatile memory, query memory* (either the configuration block space 511 of the EEPROMs, Figs. 6A, 6B, and 13, or the card attribute information register 22, Fig. 2, may be considered the recited query memory) *to store characteristics data of the memory array* (col. 18 lines 25-65, also col. 19 lines 56-65), *an interface* (17) *to receive commands from the processor* (col. 15 line 64 to col. 16 line 8), *wherein the commands are adapted based on the characteristics data* (since the configuration information includes number of chips, capacity thereof, etc., the "initialization" performed by the processor 15 "according to the configuration information" at col. 24 lines 24-32 results in the address conversion of read or write commands, thus adapting them based upon that configuration information, see col. 25 lines 23-50; that is, to select a chip and specific address the address conversion requires the configuration information, at a minimum, of number of chips and capacity thereof).

10. As to claim 22, Sukegawa discloses the apparatus substantially as described above with regard to claim 14; the interface 17 is a register interface that provides data from the query memory and commands to the non-volatile memory as recited.

11. As to claim 28, Sukegawa discloses the method substantially as described above with regard to claim 14; the claimed attribute data is considered equal to the claimed characteristics data.

12. As to claim 36, Sukegawa discloses an article comprising storage medium with instructions thereon (since the system of Sukegawa operates as a computer that is run

at least by an operating system and applications that perform the operations thereof) that perform the adapting recited, substantially as described above with regard to claim 14.

13. As to claim 15, the processor 1, Fig. 2, may be considered to adapt the commands, for example in the case where a read from the non-volatile memory is performed, in which case the data is sent to the processor, such data having been accessed (at least by address conversion as described above) based on the characteristic data, and adapted (read) by the processor based thereupon.

14. As to claims 16, 26, and 27, the memory array 11 is flash EEPROM memory (Abstract).

15. As to claims 17 and 24, the query memory is read-only memory (when considering the query memory to be part of the array of EEPROM as in the configuration block).

16. As to claim 18, the interface 17 (Fig. 2) comprises at least one register.

17. As to claim 19, the register of the interface is adapted to store at least some characteristics data (since it is sent via the interface to the host when requested).

18. As to claim 20, the interface comprises at least two registers to store at least some characteristics data (shown at 17, Fig. 2).

19. As to claims 21 and 23, the interface comprises a command register (176, Fig. 2).

20. As to claim 25, the query memory stores attributes selected from the recited group (including size of the array and of the blocks).

21. As to claims 29 and 37, the method includes reading the query memory (since the characteristics data may be requested by the host).

22. As to claims 30, 31, 38 and 39, reading the query memory includes storing the data in a register in an interface (since interface 17 is used to transfer the data).

23. As to claims 33 and 40, reading the query memory contents includes transmitting the data over a system bus to a processor (via bus 2, Fig. 2).

24. As to claims 34, 35, 41 and 42, the method includes storing a command in an interface (in command register 176, Fig. 2).

***Double Patenting***

25. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

26. Claims 1-42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,279,069.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are anticipated by those of the patent. A non-volatile memory presently claimed is anticipated by flash memory of the patent claims. Characteristics data and attribute data of the present claims are anticipated by parameter data of the patent claims. Adapting commands or initializing a device driver based upon characteristics data of the present claims are anticipated at least by patent claim 7 which recites a software driver alerted of a write parameter, and transferring data based upon the write parameter. Register interface as presently claimed is anticipated by at least the status register and queued data (registers) of the patent claims. Any remaining differences are either inherent to the structure or operation of the device claimed in the patent, or else notoriously well known in the art and obvious to an artisan to implement therein.

***Conclusion***

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

All references cited in the parent application are entered in the attached PTO-892..

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary J. Portka whose telephone number is (571) 272-4211. The examiner can normally be reached on M-F 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gary J Portka/
Primary Examiner
Art Unit 2188
February 24, 2009